

REMARKS

This Amendment and the following remarks are intended to fully respond to the Final Office Action mailed January 30, 2007. In that Office Action, claims 1-21 and 26-29 were examined, and all claims were rejected. More specifically, claims 13-21 were rejected under 35 U.S.C. § 102(e) as being anticipated by Burd (USPN 6990653) hereinafter “Burd;” and claims 1-12 and 26-29 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Burd in view of Robotham et al. (USPN 6704024), hereinafter “Robotham.” Reconsideration of these rejections, as they might apply to the original and amended claims in view of these remarks, is respectfully requested.

In this Response, claim 13 has been amended and no claims have been added or canceled. The claim amendments have been made to expedite the allowance of this application and not necessarily to overcome the cited prior art. Applicants reserve the right to pursue broader claims in future continuation applications.

Claim Rejections – 35 U.S.C. § 102

Claims 13-21 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Burd. Applicants respectfully traverse the § 102(e) rejections because either the Examiner has failed to state a prima facie case of anticipation or the current amendments to the claims now render the Examiner's arguments moot. A prima facie case of anticipation can be met only where the reference teaches each and every aspect of the claimed invention. See MPEP §§ 706.02 & 2136. Indeed, Burd does not teach a class associated with the display properties.

Burd teaches “a code generation method and apparatus to create an intermediate language or source code file from a server-side resource, the source code file then being compiled into an executable class.” *Burd*, col. 2, line 66 – col. 3, line 2. “The server computer system receives a

request from the client computer system for the web page and wherein the request identifies a dynamic web page content file.” *Burd*, col. 3, lines 18-20. The system of *Burd* creates a data model “to store elements of the dynamic web page content file, evaluates the data model and generates a source code file related to the dynamic web page content file based on the evaluation of the data model.” *Burd*, col. 3, lines 21-24. The data model does not have properties or represent a device class. Indeed, *Burd* does not teach or suggest a class associated with the display properties.

Applicants note that the limitation of a class associated with the display properties was previously included in independent claim 1. In the last Office Action, the Examiner conceded that “*Burd* doesn’t explicitly disclose the device class associated with the display properties. . . .” *Office Action*, page 6.

As such *Burd* fails to teach or suggest all of the limitations of amended independent claim 13 and therefore cannot anticipate the present invention as claimed. Furthermore, claims 14-21 depend from allowable independent claim 13 and are, thus, also allowable over the prior art. Applicants respectfully request the withdrawal of the rejections and the issuance of a notice of allowance.

Claim Rejections – 35 U.S.C. § 103

Claims 1-12 and 26-29 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Burd* in view of *Robotham et al.* (USPN 6704024). Applicants respectfully traverse this rejection because the combination of *Burd* with *Robotham* is improper under 35 U.S.C. § 103(c).

Section 103(c) states “Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention

were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person.” This statute applies to all applications pending after December 10, 2004. See MPEP § 706.02(l)(1)(I). Thus, the Examiner must examine the application as to all grounds except 35 U.S.C. 102(e), (f) and (g) as they apply through 103 only if the application file(s) establish common ownership at the time the later invention was made. See MPEP 706.02(l)(2).

The Application and Burd are Commonly Owned

Applications and references (whether patents, patent applications, patent application publications, etc.) will be considered by the examiner to be owned by, or subject to an obligation of assignment to the same person, at the time the invention was made, if the applicants or an attorney or agent of record makes a statement to the effect that the application and the reference were, at the time the invention was made, owned by, or subject to an obligation of assignment to, the same person. M.P.E.P. 706.02(l)(2)(II).

At the time of the invention, both the application and the Burd reference were owned by or under an obligation to be assigned to Microsoft Corporation. Therefore common ownership exists between the Application and Burd.

The Office Action relied on Burd for a 102(e) rejection of claims 13-21. Furthermore, the Examiner relied on Burd to reject claims 1-12 and 26-29 in a previous office action mailed on July 19, 2006. Burd clearly qualifies as prior art under section 102(e), and thus cannot be used as a reference in the 103(a) rejection. M.P.E.P. 706.02(l)(2). For this reason, § 103(c) prohibits the Examiner’s use of Burd in a 103 rejection and Applicants respectfully request that the rejection be withdrawn. Applicants further believe that, for at least this reason, claims 1-12 and 26-29 are allowable subject matter. Applicants respectfully request the withdrawal of the rejections and the issuance of a notice of allowance for all claims.

Conclusion

This Amendment fully responds to the Office Action mailed on January 30, 2007. Still, that Office Action may contain arguments and rejections and that are not directly addressed by this Amendment due to the fact that they are rendered moot in light of the preceding arguments in favor of patentability. Hence, failure of this Amendment to directly address an argument raised in the Office Action should not be taken as an indication that the Applicants believe the argument has merit. Furthermore, the claims of the present application may include other elements, not discussed in this Amendment, which are not shown, taught, or otherwise suggested by the art of record. Accordingly, the preceding arguments in favor of patentability are advanced without prejudice to other bases of patentability.

It is believed that no further fees are due with this Response. However, the Commissioner is hereby authorized to charge any deficiencies or credit any overpayment with respect to this patent application to deposit account number 13-2725.

In light of the above remarks, it is believed that the application is now in condition for allowance, and such action is respectfully requested. Should any additional issues need to be resolved, the Examiner is requested to telephone the undersigned to attempt to resolve those issues.

Respectfully submitted,



Tadd F. Wilson
Reg. No. 54,544
MERCHANT & GOULD P.C.
P.O. Box 2903
Minneapolis, Minnesota 55402-0903
(303) 357-1651

Date: March 30, 2007

